



John AF
3724
\$

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of
STEPHEN F. GASS and DAVID A. FANNING

Date: September 3, 2004

Serial No.: 10/052,806

Examiner Boyer D. Ashley

Filed: January 16, 2002

Group Art Unit 3724

For: MITER SAW WITH IMPROVED SAFETY SYSTEM

To: Commissioner for Patents
Attention: Examiner Boyer D. Ashley
Group Art Unit 3724
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY – AFTER FINAL

In the Office Action mailed July 8, 2004, the Examiner indicated that claims 6-15, 19 and 20 would be allowable except for a provisional obviousness type double patenting rejection. Applicants agree with the Examiner's conclusion regarding the patentability of the claims in the present application, but applicants traverse the double patenting rejection.

The Examiner said claims in the present application were obvious in light of claims from co-pending application serial number 10/052,273. Claims in the present application include the limitation of "a reaction system configured to stop movement of the pivot arm toward the base assembly," while claims in the co-pending application include the limitation of "a reaction system configured to urge the pivot arm away from the base assembly." The Examiner said that the limitation "configured to urge" reads on the limitation "configured to stop," and therefore a provisional double patenting rejection was warranted. Applicants disagree. A reaction system configured to urge a pivot arm away from a base assembly does not require or necessarily result in stopping

movement of the pivot arm. Expressed more generally, a force can urge a moving body away without stopping the moving body. For example, a wind blowing against the windshield of a moving car will urge the car away, but will not necessarily stop the car. Thus, a reaction system configured to urge a pivot arm away is different than a reaction system configured to stop movement of the pivot arm, and because of that difference the claims of the co-pending application cannot render the present claims obvious. MPEP 2143.03 (all claim limitations must be taught or suggested) and 804.B.1 (disclosure of co-pending application may not be used as prior art).

Even though applicants traverse the double patenting rejection, applicants are submitting a terminal disclaimer to avoid any further argument concerning this issue. Applicants understand that the provisional obviousness type double patenting rejection is now moot in light of the terminal disclaimer, and therefore, applicants request that the present application proceed to issuance. The terminal disclaimer fee is included with this response.

If the Examiner has any questions or wants to discuss this matter in more detail, the Examiner is invited to contact Applicants' undersigned attorney at the number listed below.

Respectfully submitted,

SD3, LLC



David A. Fanning, Esq.

Registration No. 33,233

Customer No. 27630

22409 S.W. Newland Road

Wilsonville, Oregon 97070


Telephone: (503) 638-6201

Facsimile: (503) 638-8601

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to number (703) 872-9306, attention Examiner Boyer D. Ashley, on the date shown below.

Date: September 3, 2004



David A. Fanning